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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,605	06/30/2000	Kia Silverbrook	NPA065US	8541

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,605

Applicant(s)

SILVERBROOK ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This is in response to application filed on June 30, 2000 in which claims 1-45 are presented for examination.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3,4, 7, [20,21, 23]/[1,4,5], 29, 30, [34-43 and 45]/30, 33, [39, 41-43, 45]/[27,31], 40/[27, 30] are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, 4, 7, 29, 30 and 33, "the sensing device sensing its movement relative to the form" is indefinite. How does any sensing device sense its own movement by itself? How and where is the sensing device maneuvered?

Regarding claims 20/[1,4,5] and 41/[27,30,31] "form is printed on a surface of a surface-defining means" is indefinite. What is a surface of a surface-defining means?

Regarding claim 21/[1,4,5] and 43/[27,30,31], "the coded data is substantially invisible in the visible spectrum" is indefinite. How and why is coded data invisible? What is visible?

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Regarding claim 23/[1,4,5], “distributing a plurality of the forms” is indefinite. What, and why is it plural?

Regarding claims [10-17]/1, [8-26]/4 and [10-17]/5 depend from 1, 4 and 5 and therefore inherit the deficiencies of those claims.

Regarding claims [34-43 and 45]/30 depend from 30 and therefore inherit the deficiencies of independent claim 30.

Regarding claims 39, 40 and 42, 45, depend from claims 29 and 41 and therefore inherit the deficiencies of those claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims [1-18, 22-25]/[1], [4-18, 23-25]/[4] and [5-18, 22-25]/[5], [27-29, 34-38, 40, 41, 43, 44]/[27], [30, 34-38, 40, 41, 43]/[30] and [31-38, 41, 43, 44]/[31] are rejected under 35 U.S.C. 102(e) as best as an Examiner is able to ascertain as being anticipated by Escallon (U.S. Patent No. 5,799,157).

Regarding claims 27, 29-33, 40/[27 and 30], 44/[27 and 31], 28, [34-38]/[27, 30 and 31], 41, 43/[27, 30 and 32], Escallon discloses a system for enabling access to travel services, the system including, (see title)

a form containing information relating to a travel service transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form; (fig. 1, 140 and, col. 5, lines 49-54), and

a computer system for receiving indicating data (fig. 1, block 10) from a sensing device for identifying at least one parameter relating to the travel service transaction, the indicating data being indicative of the identity of the form and a position of the sensing device relative to the form (fig. 1, 110), the sensing device sensing the indicative data using at least some of the coded data (fig. 1, 110).

Regarding claim 28, Escallon discloses one parameter relating to the travel service transaction is associated with at least one zone of the form (col. 5, lines 49-57).

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Regarding claim 34/[27, 30 and 32], Escallon discloses at least one parameter of the travel service transaction is selected from a group comprising an action parameter of the travel services transaction (fig. 3, blocks 301, 320, 330).

(Note: fulfilling transaction requests)

Regarding claims [35-38]/[27, 30, 31], Escallon discloses multiple parameters of travel service transactions (see col. 3, lines 1-14).

Regarding claim 41, Escallon discloses all of the claimed subject matter as discussed above with respect to claim 27 including improvements over more traditional methods such as the use of printed media (see col. 1, lines 39-47), but does not expressly discuss or use a printer.

However, it is well known to a person of ordinary skill in the relevant art that most computer systems found in offices contain a printer.

(Note: for illustrative purpose only, see Wilz, figure I)

Regarding claim 43/[27, 30 and 32], Escallon discloses a database for keeping a retrievable record of each form generated, each form being retrievable by using its identity as included in its coded data (col. 4, lines 26-40).

Regarding method claims [1-18, 22-25]/1, [4-18, 23-25]/4 and [5-18, 22-25]/5 contain same subject matter as the system claims and therefore are rejected under 35 U.S.C. 102(e) on the same basis as the claims above as anticipated by Escallon (U.S. Patent No. 5,799,157).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39/27, 39/30 and 39/31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Suda et al (U.S. Patent No. 6,157,465).

Regarding claim 39/[27,30,31], Escallon discloses all of the claimed subject matter as discussed above with respect to claims [27, 30, 31], but does not teach the sensing device includes a marking nib.

However, Suda discloses a system for transferring jobs between processing units for which he uses a (e-pen) marking device (fig. 6, 605, Suda). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an e-pen in Escallon system as used in Suda system to enter data into forms without using a keyboard. The motivation for one of ordinary skill in the art to use an e-pen would have been the convenience and flexibility of entering data to fill out forms without the use of a keyboard.

Claims [19-21, 26]/[1,4,5], 42/[27, 30, 31] and [42 and 45]/[27, 30, 31] are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Wilz Sr. et al (U.S. Patent No. 5,992,752).

Regarding claims [19-21, 26]/[1,4,5], 42/[27, 30, 31], Escallon discloses all of the claimed subject matter as discussed above with respect to claims [27, 30, 31], but does not expressly teach printing forms.

However, Wilz discloses an internet based system for enabling information-related transactions over the internet (title, Wilz) in which printing of coded transactions takes place (fig. 1, item 39, Wilz). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to print part coded forms in Escallon as done in Wilz by using a printer in conjunction with a computer. One of ordinary skill in the art would have been motivated to print forms to retain a physical copy of a transaction for record.

Conclusion

Examiner respectfully requests for the benefit of the examination that when the Applicant files an amendment to submit claims in an ordinary, non-multiple-dependent format.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MF
December 2, 2002



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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